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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,710	11/30/2000	Takashi Hasegawa	P/1071-1233	1866

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Keating & Bennett, LLP
10400 Eaton Place, Suite 312
Fairfax, VA 22030

EXAMINER

JONES, STEPHEN E

ART UNIT	PAPER NUMBER
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2817

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,710

Applicant(s)

HASEGAWA, TAKASHI

Examiner

Stephen E. Jones

Art Unit

2817

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, the phrase "said surface of said magnetic member is parallel to a direction of said DC magnetic field" is not described in the original disclosure in combination with the "longitudinal axis of said inductor" being "parallel to a surface of" the "magnetic member". The above described recitation appears to be contrary to what is described in the original disclosure (e.g. see page 10, lines 13-16, which states that the "magnetic flux passes the ferrite in its thickness direction", i.e. the magnetic flux is perpendicular to the surface of the magnet and ferrite and not parallel as the present claim states, it is the magnet surface that is parallel to the axis of the inductor). Thus the specification does not appear to support these new limitations (i.e. new matter).

Any arguments regarding this "new matter" rejection should include the location in the original disclosure where the relevant subject matter can be found.

Also, note that the above described "new matter" limitation is not given any patentable weight in the following art rejections because the new limitations would appear to make the device inoperable.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohira (JP 07-131209 of record) in view of Okada et al. (EP 0903801 A2 of record) for the reasons of record.

Regarding the new limitations, the Ohira inductor axis is parallel to the surface of the magnet (e.g. see Figs. 5-6) and inherently the magnetic flux of the inductor is perpendicular to the direction of the DC magnetic field since the DC magnetic field is through the thickness of the device (for the device to be operable) and the magnetic flux of the inductor is along its axis as is defined by fundamental inductor coil characteristics (i.e. of a toroidal coil).

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (of record) in view of Ohira (JP 07-131209 of record) and Okada et al. (EP 0903801 A2 of record) for the reasons of record.

Regarding the new limitations, the Ohira inductor axis is parallel to the surface of the magnet (e.g. see Figs. 5-6) and inherently the magnetic flux of the inductor is perpendicular to the direction of the DC magnetic field since the DC magnetic field is

through the thickness of the device (for the device to be operable) and the magnetic flux of the inductor is along its axis as is defined by fundamental inductor coil characteristics (i.e. of a toroidal coil).

Response to Arguments

6. Applicant's arguments filed 6/24/03 have been fully considered but they are not persuasive.

Applicant argues that Maeda and Ohira fail to teach the orientation of the magnetic flux of the inductor with respect to the DC magnetic field, that the axis of the inductor is parallel to the direction of the DC magnetic field, and that the magnetic flux of the inductor is perpendicular to the DC magnetic field.

These arguments are not convincing. As noted above regarding the Ohira teachings, the magnetic flux of the inductor is perpendicular to the direction of the DC magnetic field and thus parallel to the surface of the magnet since the DC magnetic field is through the thickness of the device (as noted in the previous office action) and the magnetic flux of the inductor is along its axis as is defined by fundamental inductor coil characteristics (i.e. of a toroidal coil). Regarding the argument that the axis of the inductor is parallel to the direction of the DC magnetic field, this newly added limitation appears to be new matter and is thus rejected under 112 1st paragraph as described above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen E. Jones whose telephone number is 703-305-0390. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on 703-308-4909. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

SEJ



Robert J. Pascal
Supervisory Patent Examiner
Technology Center 2800